

REMARKS

This responds to the Office Action mailed on March 21, 2007.

Claims 6 and 39 are amended, claims 1-2, 4-5, 8, and 42-46 are cancelled, and no claims are added; as a result, claims 6, 9-11, 13-15, 27-29, 37, 39-41, and 47-59 remain pending in this application.

§102 Rejection of the Claims

Claim 1 was rejected under 35 U.S.C. § 102(b) for anticipation by PCI Special Interest Group "PCI Bus Power Management Interface Specification," December 18, 1998, ("Special").

Applicant has cancelled claim 1.

§103 Rejection of the Claims

Claims 1, 2 and 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Solomon (U.S. 5,925,134; hereinafter "Solomon") in view of Campbell et al. (U.S. 5,365,587; hereinafter "Campbell").

Applicant has cancelled claims 1-2 and 4-5.

Claims 6 and 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Special in view of Mitra et al. (U.S. 6,167,472). Applicant has amended independent claim 6 to incorporate claim 8 which is not included in this rejection. Thus, Applicant respectfully submits that amended independent claim 6 is patentable over the combination of Special in view of Mitra. Withdrawal of the rejection of amended independent claim 6, and claims 9 and 10 which depend therefrom, is respectfully requested.

Claims 6, 8, 37-41 and 47-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art (AP) in view of Campbell et al.

Applicant has cancelled claim 8 and amended independent claim 6 to include the language of cancelled claim 8.

Applicant respectfully traverses the rejection based on AP and Campbell is derived from impermissible hindsight because one of skill in the art using common sense would not have made the asserted combination.

Campbell describes a mechanism whereby a central electronic complex 16 (FIG. 1) includes a B module 28 (FIG. 1 and Fig. 2) to buffer and control instructions and data for the processor. Col. 4, line 61 - col. 5, line 20. B module 28 includes a multi-chip module 40 (FIG. 2 and FIG. 3) that includes control and security logic chip 50 (FIG. 3). Control and security logic chip 50 is coupled to multiple nonvolatile memory storage devices, such as EEPROM 52 and EEPROM 54 (FIG. 3). Col. 5 lines 55-59. A personality register may be established within the secure portion of control and security logic chip 50 and utilized to store data which has been retrieved from EEPROM 52 and EEPROM 54 to selectively alter functional characteristics of computer 302. Col. 56, lines 63-68. Thus, the personality register is within the control and security logic chip 50 which is part of the B module 28. Alteration of functional characteristics of the computer 302 are all performed within the single B module 28. As a result, there is only one "personality register" which is asserted in the Office Action to be the same as a capabilities list. This personality register allows selective altering of functional characteristics of a data processing system without physical or mechanical manipulation. Campbell, Abstract.

In making the combination of Campbell with AP, the Office Action asserts that the motivation for making the combination would be to "allow the manufacturer to store a full set of capabilities in a peripheral device and selectively enable a specific subset of those capabilities support for a particular device; where, in the instant of AP system, the manufacturer only needs to simply modify the node pointer in the hardware linked list to define a different set of capabilities for each different peripheral device. Furthermore, the method of Campbell would permit the functional capabilities of a peripheral device to be selectively modified without necessity of physical or mechanical manipulation."

Applicant respectfully submits that one of skill in the art, when presented with Campbell and the asserted AP would utilize the centralized personality register of Campbell to bring all potential capabilities into a single location for manipulation because Campbell already provides a solution to the asserted motivation for making the combination. Namely, allowing selective altering of functional characteristics of a data processing system without physical or mechanical

manipulation. As shown above, the abstract of Campbell explicitly states that this is a solution provided. If one of skill in the art is provided with a solution to a problem, common sense dictates that solution should be used. Thus, Applicant respectfully submits that one of skill in the art, at the time of the invention, if presented with Campbell and AP would have used Campbell rather than inventing applicants solution which includes a capabilities list in each peripheral device. As such, Applicant respectfully submits that the combination of Campbell and AP is based on impermissible hindsight. Withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 6, 8, 37-41 and 47-59 is earnestly requested.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

A. K. PORTERFIELD

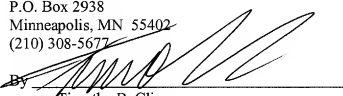
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16 June '07

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14 day of June 2007.

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